REMARKS

Claims 1-9, 11, 20-21, 23-24, and 26-33 are pending in the present application. All claims of the present application were finally rejected in the Final Office Action. A telephone interview was conducted on September 4, 2007, between the Examiner, the undersigned, and Jonathan Small, attorneys for applicant. An Interview Summary is submitted herewith. Applicant appreciates the Examiner's time and willingness to further consider this case in the interview, helpful suggestions to move the case toward allowance.

Following the discussion held in the aforementioned interview, the Examiner suggested applicant file this Request for Reconsideration. It contains the arguments presented in the interview, together with an amendment to claim 20, as suggested by the Examiner. Accordingly, applicant respectfully requests the Examiner's further consideration of the arguments, entry of the amendment to claim 20, and further consideration and allowance of all claims.

35 U.S.C. § 101

Initially, in the Final Office Action, claims 20, 21, 23, and 24 were rejected under 35 USC 101. It was asserted in the Final Office Action that these claims are directed to a stream of information, or energy, and are therefore non-statutory. In response, claim 20 has been amended to append the word "physical" to the limitation "computer-readable storage medium", thus eliminating the possibility that the claim is directed to energy per se. Applicant appreciates the Examiner's indication that such an amendment would overcome the rejection under 35 USC

101, that such an amendment would be entered, and that the finality of the rejection on this ground would be removed.

Claims 21, 23, and 24 each depend from claim 20, and therefore contain all of its limitations. As the amendment to claim 20 addresses the rejection under 35 USC 101, that amendment must therefore also address the rejection of claims 21, 23, and 24 on such grounds. Accordingly, applicant asserts that claims 20, 21, 23, and 24 meet the statutory requirements of 35 U.S.C. 101.

35 U.S.C. § 102(e)

Claims 1-9, 20, 21, 23, 24, and 31-33 were rejected as anticipated under 35 U.S.C. § 102(e) by Musgrove et al. (USP 6,535,880) in light of the Smartshop.com website. Applicant summarizes the arguments made in the aforementioned interview in support of the assertion that the claims patentably distinguish over the disclosure of Musgrove and the traversal of this rejection.

As in the interview, applicant initially offers a brief description of the present invention. Much valuable data can be obtained by observing and analyze a buyer's browsing and shopping habits. For instance, it is useful to note which marketing campaigns are successful with a buyer and which are not. Which forms of presentation of products result in sales and which do not. Which products are select by a buyer and which are rejected. In terms of the Internet, such additional matters as which websites does a buyer prefer and which does he or she avoid are very relevant. Accordingly, the present invention seeks to observe and record a

user's (e.g., a buyer's) preferences by monitoring interactions the user has with product data presented typically by a web server hosting an on-line commerce site.

The primary reference, Musgrove (USP 6,535,880) focuses on a fundamentally different problem. Musgrove seeks to provide a single web site which integrates a number of different retail sites together, thus freeing a user from having to visit the different retail sites. Easy comparison shopping and uniform buyer data collection assist buyers with the purchasing process. And reducing the number of sites a buyer needs to visit reduces the time and burden required for a buyer to purchase products.

Importantly, Musgrove seeks to reduce the number of different sites a buyer needs to visit in order to make a purchase, while the present invention benefits from a user having a relatively large number of interactions with different web sites. That is, while the primary objective of the present invention is to capture user interaction with different web pages (referred to as "point of presentation", see e.g., para. 0025, lines 1-4), the primary objective of Musgrove is to reduce the number of different pages with which the user actually must interact (use of a "single shopping interface", see e.g., col. 3, lines 26-26).

In the interview, the undersigned argued that this is borne out by the language of the claims, and in particular claim 1. The undersigned used Fig. 1 of the Musgrove reference to illustrate the difference. Applying the terminology from claim 1 of the present application to this figure, it was explained that if the first location (of claim 1) corresponds to the Shopping Server 20 of Musgrove, the second location corresponds to the Client 12 of Musgrove, and the third location corresponds to any of the Merchant Servers 40 of Musgrove, then according to claim 1, product information from interactions between second and third locations being stored in the first location means that Musgrove would have to teach storing in Shopping Server 20 product

information from interactions between client 12 and Merchant Servers 40. However, the undersigned argued that this is not what Musgrove teaches. Rather, Musgrove teaches automated interactions (col. 5, lines 20-21) between Shopping Server 20 and Merchant Server 40 in order to populate Shopping Server 20, and client-side interactions limited to interactions with Shopping Server 20 (i.e., no product information from interactions between Client 12 and Merchant Servers 40). Indeed, this is the very type of interaction from which Musgrove is attempting to free the user:

Stated in terms of claim 1 of the present application: a merchandising product database at a first network location is populated by obtaining merchandising data from at least one user interaction with the data at a point of presentation at a second network location, where the data is obtained from a server at a third network location. In these terms, however, Musgrove discloses populating a shopping server with product data (obtained by automated processes and without user interaction, col. 5, lines 20-21), then user interaction between only the user and the shopping server. That is, there is no "obtaining step comprising acquiring selected product information from at least one user interaction at a second network location with a presentation medium obtained from a server at a third network location" (claim 1, lines 4-6). Again, this is the very interaction from which Musgrove is trying to free the user.

Furthermore, as stated in Applicant's prior response, the claimed concept of obtaining information based on a user's interaction with that information must be distinguished from what is taught by Musgrove, in which a web crawler (col. 5, lines 18-22) "scrapes" content from web sites (e.g., merchant servers 40) independent of whether a user has interacted with that content.

This difference is important. In the case of crawlers, content (more particularly product information) is obtained without any indication of the significance of that content to the user

population. In the case of the collection of data with which a user has interacted (e.g., selection for actual viewing), also referred to in this application as data collection at the point of presentation, the captured data in and of itself reflects the significance of that content to the user population. For example, if data is selected to be viewed by a user, that data may be captured and associated with the fact that it was selected for viewing. Conversely, the mere fact that certain product information is collected by the merchandising database of the claimed invention indicates that the product has been viewed by a user. Other user-behavioral information (e.g., how many people saw the products at a merchant site, when the products were viewed by visitors to the merchant site, how the visitors reach the merchant site) may be inferred from the collected data as well. No such behavioral information could be inferred from product information collected by web crawlers, as there is no user interaction with the data collected.

Thus, the undersigned argues that there are two fundamental limitations in claim 1 (as well as claims 8, 20 and claims depending therefrom) not found in Musgrove:

(1)   there is no "obtaining step comprising acquiring selected product information from at least one user interaction at a second network location with a presentation medium obtained from a server at a third network location" (claim 1, lines 4-6); and

(2)   populating a merchandising database with "selected product information from at least one user interaction" (claim 1, lines 4-5)

It is well established that "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a

single prior art reference." <u>Verdegaal Bros. v. Union Oil Co. of California</u>, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See also M.P.E.P. § 2131. Thus, since Musgrove fails to teach each element of the claims, it cannot render those claims unpatentable under 35 U.S.C. 102(e).

Similarly with regard to claim 26 (and claims depending therefrom), at least a portion of an interactive catalog is obtained from a third network location and rendered <u>in response to user interaction therewith</u> at a second network location such that selected data from the rendered portion is communicated to a first network location "by way of the second network location" (claim 26, lines 7-9). As discussed, the limitations "rendering <u>in response to user interaction</u>...a description of one or more products" (claim 26, lines 3-4, emphasis added) and "wherein content of the rendered portion includes a description of one or more products and wherein the content is obtained from one or more source product databases <u>at a third network location</u>" (claim 26, lines 4-6, emphasis added) are not found in Musgrove. Therefore, applicant asserts that Musgrove fails to teach each element of claim 26, and claims depending therefrom, and again pursuant to <u>Verdegaal Bros.</u>, supra, that reference fails to render those claims unpatentable under 35 U.S.C. 102(e).

Conclusion

For the foregoing reasons explained in the interview with the Examiner dated September 4, 2007, reconsideration of the present application is respectfully requested. Applicant asserts that the Musgrove does not teach or suggest critical features of the present invention, and that therefore the present application is clearly allowable over that reference. Accordingly, favorable

reconsideration, removal of the final rejection, and issuance of a formal Notice of Allowance for this application in light of the amendment and remarks provided above is respectfully requested.

By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-969-8300.

Respectfully submitted,

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